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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/785,572
Filing Date: February 16, 2001
Appellant(s): PICKOVER ET AL.

Nathaniel Levin
Reg. No. 34,860
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 15, 2004.

(1)   ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal is

contained in the brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   ***Grouping of Claims***

Examiner acknowledges that Appellant has grouped claims 1-5, 9, 10, 14-23, 25,

and 26 separately from claims 6 and 24.

The rejection of claims 1-5, 9, 10, 14-23, 25, and 26 stand or fall together because

appellant's brief does not include a statement that this grouping of claims does not stand

or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 6 and 24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

6553507	Cohen	4-2003
6167358	Othmer et al.	12-2000
6151643	Cheng et al.	11-2000

(10)   *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 9, 10, and 14-26 are rejected under 35 U.S.C. 103.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 9,10, 20-23, and 25-26 are rejected under 35 U.S.C. **103(a)** as being unpatentable over by US Patent No. 6,553,507 of Cohen in view of US Patent No. 6,167,358 of Othmer et al. referred hereinafter "Othmer".

In regards to claim 1, Cohen discloses a method of supporting a software program, comprising:

receiving error data for at least a first error (see column 2 lines 56-57);

identifying a patch for said at least first error (see column 2 lines 59-61); and

forwarding said patch to update said software program (see column 2 lines 65-67)

However, Cohen has failed to explicitly disclose said at least first error including a user error performed by a user in operating the software program.

Othmer discloses a method of receiving error data for at least a first error, said at least first error including a user error performed by a user in operating the software program. Othmer states, "When a user of a particular client computer has a software crash, the manager may use the information from the black boxes for that particular client computer to help determine the cause of the crash. The manager may also be able to determine if the crash result from human error (i.e., the user selected the wrong function to execute) ..." (see column 7 lines 42-47). Furthermore, Othmer discloses having solutions (patch) for such errors reduces the need for customer support to repeatedly solve known problems. Othmer states, "the system may generate automatic rules that indicate the solution to the known error which reduces the need for customer support people to repeatedly solve known errors " (see column 2 lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made wherein said at least first error including a user error performed by a user in operating the software program. A person of ordinary skill in the art would have been motivated to make such a combination because Cohen discloses identifying errors and forwarding a patch to provide a solution (see column 2 lines 56-67), and user error performed by a user in operating the software program is a known type of error that requires a solution, as per teaching of Othmer (column 7 lines 42-47). Furthermore, providing solutions (patch) for user errors, as indicated in the teaching of Othmer, reduces the need for customer support to repeatedly solve known problems (see column 2 lines 55-60).

In regards to claim 2, Cohen discloses wherein first data comprises first data identifying said at least first error (see column 2 lines 50-51).

In regards to claim 3 and 4, Cohen discloses wherein said first data includes an error code and an application identifier (see column 2 lines 20-25 and 50-55).

In regards to claim 5, Cohen discloses monitoring said software program for the generation of errors, and identifying said at least first error (see column 2 lines 1-15 and 40-55).

In regards to claim 9, Othmer discloses wherein said user error is a failure to properly operate said software program (see column 7 lines 42-45).

In regards to claim 10, Othmer discloses wherein the user error is a failure to efficiently operate said software program (see column 7 lines 42-45).

In regards to claim 20, Cohen disclose wherein error data further comprises:

second data identifying at least a first condition under which said at least first error occurred (see column 2 lines 50-55).

In regards to claim 21, Cohen discloses a device for supporting software on at least a first user device, comprising:

a processor (see figure 1 item 106);

a communication device, coupled to said processor, receiving error information for at least a first error from said at least first user device (see figure 1 and column 2 lines 56-57); and

a storage device in communication with said processor and storing instructions adapted to be executed by a processor (see figure 1 and column 2 lines 10-13) to:

identifying a patch for said at least first error (see column 2 lines 59-61); and

forwarding said patch to update said software on said at least first user device (see column 2 lines 65-67);

However, Cohen has failed to explicitly disclose said at least first error including a user error performed by a user in operating the software program.

Othmer discloses receiving error data for at least a first error, said at least first error including a user error performed by a user in operating the software program. Othmer states, "When a user of a particular client computer has a software crash, the manager may use the information from the black boxes for that particular client computer to help determine the cause of the crash. The manager may also be able to determine if

the crash result from human error (i.e., the user selected the wrong function to execute)
..." (see column 7 lines 42-47). Furthermore, Othmer discloses having solutions (patch)
for such errors reduces the need for customer support to repeatedly solve known
problems. Othmer states, "the system may generate automatic rules that indicate the
solution to the known error which reduces the need for customer support people to
repeatedly solve known errors " (see column 2 lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time the
invention was made wherein said at least first error including a user error performed by a
user in operating the software program. A person of ordinary skill in the art would have
been motivated to make such a combination because Cohen discloses identifying errors
and forwarding a patch to provide a solution (see column 2 lines 56-67), and user error
performed by a user in operating the software program is a known type of error that
requires a solution, as per teaching of Othmer (column 7 lines 42-47). Furthermore,
providing solutions (patch) for user errors, as indicated in the teaching of Othmer,
reduces the need for customer support to repeatedly solve known problems (see column 2
lines 55-60).

In regards to claim 22, Cohen discloses wherein said error information comprises:

first information identifying said at least first error (see column 2 lines 50-51);
and

second information identifying at least a first condition under which said at least
first error occurred (see column 2 lines 50-55).

In regards to claim 23, Cohen discloses said first information includes at least an
error code and an application identifier (see column 2 lines 20-25 and 50-55).

In regards to claim 25, Cohen disclose a system for supporting software
comprising:

at least a first user device having a processor(see figure 1 item 106 and column 2
line 9);

a communication device, coupled to said processor, configured to send and
receive data over a network (see figure 1 and column 2 lines 55-56); and

a storage device in communication with said processor and storing instructions adapted to be executable by said processor to execute at least a first software program, monitor said at least first software program for errors, and forward error information about an at least first error to a controller(see figure 1 and column 2 lines 10-13 and 56-67) and ,

said controller having a controller processor, a controller communication device, coupled to said controller processor, configured to send and receive data over said network, and a storage device in communication with said controller processor to receive said error information about said at least first error, identify a patch for said at least first error; and forward said patch to update said at least first software program on said at least first user device (see column 2 lines 56-67).

However, Cohen has failed to explicitly disclose said at least first error including a user error performed by a user in operating the software program.

Othmer discloses receiving error data for at least a first error, said at least first error including a user error performed by a user in operating the software program. Othmer states, "When a user of a particular client computer has a software crash, the manager may use the information from the black boxes for that particular client computer to help determine the cause of the crash. The manager may also be able to determine if the crash result from human error (i.e., the user selected the wrong function to execute) ..." (see column 7 lines 42-47). Furthermore, Othmer discloses having solutions (patch) for such errors reduces the need for customer support to repeatedly solve known problems. Othmer states, "the system may generate automatic rules that indicate the solution to the known error which reduces the need for customer support people to repeatedly solve known errors " (see column 2 lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made wherein said at least first error including a user error performed by a user in operating the software program. A person of ordinary skill in the art would have been motivated to make such a combination because Cohen discloses identifying errors and forwarding a patch to provide a solution (see column 2 lines 56-67), and user error performed by a user in operating the software program is a known type of error that

requires a solution, as per teaching of Othmer (column 7 lines 42-47). Furthermore, providing solutions (patch) for user errors, as indicated in the teaching of Othmer, reduces the need for customer support to repeatedly solve known problems (see column 2 lines 55-60).

In regards to claim 26, see basis for rejection for claim 1. Claim 26 is simply a computer readable storage medium, which stores a program for implementing the method set forth in claim 1, and therefore is necessarily included in the teachings of Cohen.

Claims 6, 14-19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of Othmer and in further view of US Patent No. 6,151,643 of Cheng et al. referred hereinafter "Cheng".

In regards to claim 14-16, Cohen in view of Othmer discloses all the claimed subject matter, except wherein said forwarding said patch further comprises forwarding support information to said user device, wherein support information includes an advertisement and set of instructions for operating said software program.

Cheng disclose forwarding support information to the user device, wherein support information includes an advertisement and set of instructions for operating said software program. Cheng states each software update is associated with information that describes the particulars for the installation, such as configuration, decompression, or other information (see column 8 lines 55-62). Furthermore, Cheng discloses sending information, advertisements and other promotional material to each specific user, indicating support information including an advertisement (see column 22 lines 29-34), and downloading a software update, along with installation program, files, or the like (see column 8 lines 36-40), indicating instructions for operating said software program.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include support information, wherein support information includes an advertisement. A person of ordinary skill in the art would have been motivated to make the modification to Cohen in view of Othmer because advertisement, as per teaching of Cheng, would make the user aware of information associated or derived from the software program, which mostly likely be of interest to the user, as per teaching

Cheng (see column 22 lines 63-66). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include support information, wherein the support information includes a set of instructions for operating said software program. A person of ordinary skill in the art would have been motivated to make the modification because installation programs, files or the like, indicating instructions for operating said software program, is known and commonly used to provide a means for the installation of the update or patch, as per teaching of Cheng (see column 8 lines 55-62).

In regards to claim 17, Cohen in view of Othmer discloses all the claimed subject matter, except receiving payment for said patch.

However, Cheng discloses receiving payment for patch (see column 9 lines 17-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive payment for the patch. A person of ordinary skill in the art would have been motivated to receive payment for the patch because Cohen in view of Othmer discloses forwarding a patch for updating software, thus providing service, and Cheng discloses receiving payment for a software update, thus providing reimbursement for the service.

In regards to claim 18, Cheng discloses wherein said payment is received from a user of said user device (see column 9 lines 17-21).

In regards to claim 19, Cheng discloses wherein said payment is received from a provider of said software program (see column 9 lines 22-27).

In regards to claim 6 and 24, Cohen in view of Othmer discloses all the claimed subject matter, except notifying a third party of said at least first error.

However, Cheng discloses a system comprising a plurality of software vendor computer systems that automatically provides software updates/patches to client computers and a service provider computer system that connects the client computer to a particular software vendor (see figure 1 and column 2 lines 61-65). Cheng further discloses when receiving payment for patch in a system having a plurality of software vendors, "the cost of the service may be included in the cost of the software update

charged by the software vendor, who then pays the service provider for the service of coordinating and linking end users to the software vendor's computer" (see column 9 lines 22-27). When receiving payment for the patch, the service provider (third party) is notified of at least the first error in order to provide the update or patch for the error.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a system including a plurality of software vendor computer systems that automatically provides software updates/patches to client computers and a service provider computer system that connects the client computer to a particular software vendor. A person of ordinary skill in the art would have been motivated to combine the teachings because Cohen discloses a software vendor providing software updates/patches for faults or errors to software programs in a computer, and expanding to a plurality of software vendors, as per teaching of Cheng, provides software updates/patches for a plurality of software programs manufactured by diverse software vendors (see column 2 line 67 to column 3 line 1). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receive payment for the patch, wherein said payment is received from a provider of said software program, indicating notifying a third party of at least first error. A person of ordinary skill in the art would have been motivated to receive payment for the patch because Cohen in view of Othmer discloses forwarding a patch for updating software, thus providing service, and Cheng discloses receiving payment for a software update, thus providing reimbursement for the service.

(11)   *Response to Argument*

Group 1

In response to applicant's argument presented page 8 "Considering claim 1 as a whole, and not merely as an unrelated collection of method steps, one observes that claim 1 call for identifying a patch for a user error performed by a user in operating a software program. Neither Cohen and Othmer taken alone, nor their combination, produces the

insight provided in the present application that a user error may be automatically sending patches from a server to the user's computer. Cohen, as mentioned above, does not refer at all to user errors, but rather corrects bugs present in programs by automatically sending patches from a server to a user computer. Othmer recognizes that user error may be reported from a client computer to a server for the information of a system manager. But Othmer fails to take the further step, taught in the present application, of automatically remedying user errors by downloading patches therefore to the user computers. That is, Othmer fails to recognize that user errors may be treated in the same fashion that Cohen treats program errors, and so may be automatically remedied with patches. Rather, this additional advancement of the art is provided only by the teaching of the present application. Thus Othmer fails to make up for the deficiency in Cohen that was recognized by the Examiner," examiner respectfully disagrees.

As disclosed in the specification, the applicant's inventive concept is a system that provides patches for errors in general. The specification discloses that "the term 'error' can refer to any condition indicating a failed action of a software program including, for example: general protection faults, failed request, hard or soft errors, and the like. Further, as used herein, the term error also includes user errors including user inefficiencies in operating software and/or user input errors. 'Error' also refers to errors in data such as those produced by a scratch on media such as CDROM, digital video disk (DVD), or more generally, those present in a corrupted data file" (see page 4 of specification). Similar to applicant's invention, Cohen discloses a system that provides patches for errors in general, as discloses in the rejection above.

However, the applicant discloses in claim 1 that the error, which the system provides a patch for, is specifically "a user error performed by a user in operating the software program". The applicant's disclosure, more specifically the applicant's specification, does not indicate that "a user error performed by a user in operating the software program" as recited in applicant's claims is any more critical with respect to other types of errors as disclosed on page 4 of the specifications. The applicant's specification does not disclose how providing a patch for a user error is differentiated from finding a patch for any other type of error.

Nevertheless, Othmer discloses the limitation of receiving error data for at least a first error, said at least first error including a user error performed by a user in operating the software program. Othmer states, "When a user of a particular client computer has a software crash, the manager may use the information from the black boxes for that particular client computer to help determine the cause of the crash. The manager may also be able to determine if the crash result from human error (i.e., the user selected the wrong function to execute) ..." (see column 7 lines 42-47). Furthermore, Othmer discloses having solutions (patch) for such errors reduces the need for customer support to repeatedly solve known problems. Othmer states, "the system may generate automatic rules that indicate the solution to the known error which reduces the need for customer support people to repeatedly solve known errors " (see column 2 lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made wherein said at least first error including a user error performed by a user in operating the software program. A person of ordinary skill in the art would have been motivated to make such a combination because Cohen discloses identifying errors

and forwarding a patch to provide a solution (see column 2 lines 56-67), and user error

performed by a user in operating the software program is a known type of error that

requires a solution, as per teaching of Othmer (column 7 lines 42-47). Furthermore,

providing solutions (patch) for user errors, as indicated in the teaching of Othmer,

reduces the need for customer support to repeatedly solve known problems (see column 2

lines 55-60).

Examiner further points out in response to applicant's arguments against the

references individually, one cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re

Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091,

231 USPQ 375 (Fed. Cir. 1986). As indicated in claim 1 rejection above, Cohen clearly

teaches a method of supporting a software program in which a patch is identified for

errors in general. When combined with Othmer, who discloses the need to find the

solution or patch for a particular type of error, which is a user error, Cohen in view of

Othmer teaches the claimed limitation.

In response to applicant's argument that the examiner's conclusion of obviousness

is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning.

But so long as it takes into account only knowledge which was within the level of

ordinary skill at the time the claimed invention was made, and does not include

knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, as

indicated in the above rejection, it would have been obvious to one of ordinary skill in the

art at the time the invention was made wherein said at least first error including a user

error performed by a user in operating the software program. A person of ordinary skill

in the art would have been motivated to make such a combination because Cohen

discloses identifying errors and forwarding a patch to provide a solution (see column 2

lines 56-67 of Cohen), and user error performed by a user in operating the software

program is a known type of error that requires a solution, as per teaching of Othmer

(column 7 lines 42-47). Furthermore, Othmer discloses having solutions (patch) for such

errors reduces the need for customer support to repeatedly solve known problems (see

column 2 lines 55-60 of Othmer).

Group 2

In response to applicant's argument on page 10, "the Examiner's previous point is

a non sequitur. There is nothing about having a payment system that requires that user

errors be reported by the software vendor to a third party such as a software provider that

acts as an intermediary. Indeed Cheng is silent to user errors and the Examiner presents

no logical reason why a payment includes notification to a third party concerning a user

error. Rather, it appears that the Examiner has read this feature into the combinations of

references based on impermissible hindsight guidance of the present invention,"

examiner respectfully disagrees.

As disclosed in the above rejection, Cheng discloses a system comprising a

plurality of software vendor computer systems that automatically provides software

updates/patches to client computers and a service provider computer system that connects

the client computer to a particular software vendor (see figure 1 and column 2 lines 61-

65). Cheng further discloses when receiving payment for patch in a system having a plurality of software vendors, "the cost of the service may be included in the cost of the software update charged by the software vendor, who then pays the service provider for the service of coordinating and linking end users to the software vendor's computer" (see column 9 lines 22-27). When receiving payment for the patch, *the service provider (third party) is notified of at least the first error* in order to provide the update or patch for the error.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that Cheng is silent to user errors, the limitation of user errors is disclosed in Othmer.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a system including a plurality of software vendor computer systems that automatically provides software updates/patches to client computers and a service

provider computer system that connects the client computer to a particular software vendor. A person of ordinary skill in the art would have been motivated to combine the teachings because Cohen discloses a software vendor providing software updates/patches for faults or errors to software programs in a computer, and expanding to a plurality of software vendors, as per teaching of Cheng, provides software updates/patches for a plurality of software programs manufactured by diverse software vendors (see column 2 line 67 to column 3 line 1). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receive payment for the patch, wherein said payment is received from a provider of said software program, *indicating notifying a third party of at least first error*. A person of ordinary skill in the art would have been motivated to receive payment for the patch because Cohen in view of Othmer discloses forwarding a patch for updating software, thus providing service, and Cheng discloses receiving payment for a software update, thus providing reimbursement for the service.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

ecp
July 22, 2004

Conferees:
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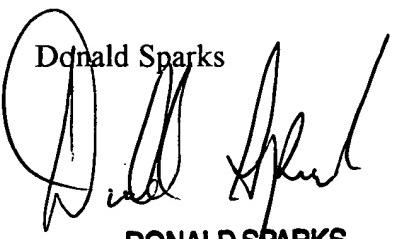
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